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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,228	07/23/2003	Roana Antonio	BA22856	8632

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Bucknam and Archer
1077 Northern Boulevard
Roslyn, NY 11576

EXAMINER

COMPTON, ERIC B

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,228

Applicant(s)

ANTONIO, ROANA

Examiner

Eric B. Compton

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/100,605.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

In claim 1, the use of "and/or" renders the claims indefinite because it is unclear which of the limitation(s) are part of the claimed invention, and the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Also, line 5, "it" is indefinite, since it is not clear which this is referring to.

In claims 2 and 8, the preambles of these dependent claims should be consistent. Also with regards to claim 2, this claim is redundant with language already contained in claim 1. Also, in claim 2, the limitations "the center section," "the two extremities" and "the interior and exterior" lack antecedent basis. In claim 8, line 2, "it" is indefinite, since it is not clear what this is referring to. Also, in claim 8, the use of "and/or" renders the claims indefinite because it is unclear which of the limitation(s) are part of the claimed invention, and the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

Claim 3, is directed to a "A process for the preparation of a manufactured product ...". However, there are no positively recited method steps, e.g., winding a filament onto a lamina.

Regarding claims 4-7, many of the dependent claims have redundant subject matter.

These are just a few of the problems noted by Examiner. Applicant is requested to review the claims in full and make changes where appropriate to conform the claims to U.S. practice.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by JP02-057202 to HOJO.

Regarding claim 1, HOJO discloses an ornamental product comprising: a filament (1) of precious material spirally wound on a woven strip (5, see Col. 4, lines 5-6) of a precious or non-precious material, wherein portions along the longitudinal axis have different widths (at 6a). See Figure 3.

Regarding claims 2 and 8, see Figure 3 (showing a variable width, which decreased from the center section towards the ends).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Target in view of U.S. Pat. 1,766,971 to Augenstein.

Target discloses a method of forming a wound type product, e.g., a necklace comprising a base, said base constituted by a metallic lamina (6), which is coupled to a strip (5) and a filament spirally (4) wound on said strip. Target suggests the necklace is secured to the woven strip (5) after it is spiral wound on a mandrel. See Col. 3, lines 48-49. However, Target does not suggest connecting the strip to the mandrel during the winding process.

Augenstein discloses winding filaments around a flexible core. The flexible band provides additional support to prevent crushing. See Col. 1, lines 16+; see *also* Applicant's Admitted Prior Art, Specification, page 1 (disclosing use of core to provide rigidity).

Regarding claim 3, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed the product of Target, by

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connecting the strip to the mandrel during the winding process, in light of the teachings of Augenstein, in order to provide additional support and rigidity.

Regarding claim 4, Target discloses the lamina (6) is metallic. See Col. 2, lines 57-58.

Regarding claim 5, Target discloses the lamina (6) may be dissolved in a chemical bath. See Col. 3, lines 28-31.

Regarding claim 6, Target discloses pressing the workpiece to remove gaps of discontinuity. See Col. 3, lines 20+. Finishing processes known in the art are provided for as well. See Col. 3, lines 50+. One having ordinary skill in the art at the time the invention was made would recognize that polishing, for example, would be advantageous to make the product formed more shiny.

Regarding claim 7, Target show two end portions (7) where the mandrel (6) is positioned for rotation. Furthermore, the reference discloses that winding is carried out by mechanical equipment, suggesting motors. See Col. 3, lines 5+. Likewise Target discloses that it is important to maintain constant tension of the coils. Therefore, it is inherent that some control means are provided for doing so, e.g., electronic means.

Note: providing a mechanical of automatic means to replace manual activity, which has accomplished the same result involves only routine skill in the art.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (571) 272-4527. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric B. Compton
Primary Examiner
Art Unit 3726

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